The Rejection Under 35 U.S.C. §112, ¶2

The Examiner has rejected claims 3 and 4 under 35 U.S.C. §112, ¶2 on the asserted basis that the term "hydrogen bond donator or acceptor" is vague and indefinite. For the reasons previously submitted, Applicants believe that those of skill in the art would readily understand the meaning of this common term. However, to advance the prosecution of this case Applicants have cancelled these claims without prejudice.

The Rejection Under 35 U.S.C. §103

The Examiner has rejected claims 1-11 and 14-15 under 35 U.S.C. §103 as being unpatentable over Hotamisligil in view of Failli (U.S. 5,218,124). The Examiner takes the view that Failli discloses that the elected compound is a known aP2 inhibitor. Applicants have pointed out that Failli makes no such disclosure, but instead teaches that the elected compound is a PLA_2 inhibitor, which has different utility than an aP2 inhibitor. The Examiner has responded by asserting that despite what Failli may actually teach, Applicants have "admitted" that Failli teaches the elected compound to be an aP2 inhibitor. The rejection is improper because Applicants have made no such admission. The Examiner has contorted language in Applicants' specification to manufacture this "admission".

The Examiner points the following specification language as a supposed explicit admission that Failli teaches the elected compound to be an aP2 inhibitor:

> "Examples of aP2 inhibitors suitable for use herein include compounds which include an oxazole or analogous ring. Thus, U.S. Patent No. 5,218,124 to Failli et al. (the disclosure which is incorporated herein by reference) discloses compounds which have activity as aP2 inhibitors and thus suitable for use herein...."

(See specification at page 4, lines 2-7). This statement simply reports Applicants **own discovery** that oxazole compounds, such as those disclosed in Failli, are aP2 inhibitors (in addition to being PLA_2 inhibitors, as taught by Failli) and thus useful to treat diabetes (Failli only discloses the compounds to be useful as an anti-inflammatory agent, an anti-allergic agent or a cytoprotective agent). Applicants are entitled to claim this discovered new use for the compounds of the present invention. It is improper for the Examiner to use Applicants' own disclosure/description of the invention as prior art to reject these claims. See, In rePleuddemann, 15 USPQ2d 1738, 1742 (Fed. Cir. 1990). Applicants respectfully request that the Examiner withdraw the §103 rejection.

Conclusion

Applicants request that the Examiner reconsider the case and pass all pending claims to allowance in view of the above amendments and remarks.

Respectfully submitted,

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